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Ronald L. Grudziecki, Esquire
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/749,918 | Applicant(s) VAN DER MEER, HENDRIK THEODORUS | |
| | Examiner Nathan Hillery | Art Unit 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 12/8/04.
2. Claims 1 – 35 are pending in the case. Claims 1, 4, 5, 19, 22 and 23 are independent.
3. The rejection of claims 7,8,11 and 29 under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.
4. The rejection of claims 1 – 35 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels, Jr. et al. (US006343327B2) and further in view of McCauley et al. (US006434578B1).

3. ***Regarding independent claim 1***, Daniels, Jr. et al. teach that *a user at a sender's mainframe 100 submits to printstream processor 102 documents in a printstream, addressing information in the form of delivery preferences stored in a database, and control information specifying, e.g., what inserts are to be included with each document in the printstream (Column 3, lines 26 – 31) and that the physical delivery printstream is sent from the printstream processor 102 to a printer 104 where*

*the documents in the physical delivery printstream are printed on a tangible medium such as paper. The printed documents are sent to a physical inserter 106 where they are processed into physical mail pieces. For example, a physical mail piece may contain a properly addressed envelope with the proper postage and stuffed with the printed document. In addition, the envelope may include additional printed matter, called physical inserts, selected according to criteria in the control information. The physical mail pieces are then ready for delivery by traditional means, e.g. through the U.S. Postal Service (Column 3, lines 56 – 67), which provide for **selecting presentation instructions** (addressing information) **valid for said messages, for determining at least one form of presentation of said messages to said addressees; and at least making ready for mailing said messages in accordance with said file of content-determining instructions and said presentation instructions; wherein selecting said presentation instructions occurs by selecting a single, priorly stored file of presentation instructions; and wherein said file of presentation instruction contains instructions concerning the processing of the document.*** Daniels Jr. et al. do not explicitly teach **said file of presentation instruction contains instructions concerning the design of the document itself.**

However, McCauley et al. do teach that server system 12 is responsive to page specifications authored independently, by different authors, to render information pages at a plurality of clients that use different client viewers. An information page is an arbitrary unit of information content that is typically provided to a client as a unit. Each page specification indicates page content and an associated page design for an

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*information page (Column 4, lines 28 – 34), which provide for **transferring a file of content-determining instructions determining the content of said messages and said presentation instructions to a peripheral device for at least making ready for mailing said messages; said file of presentation instruction contains instructions concerning the design of messages themselves and concerning the processing of the messages.*** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Daniels, Jr. et al. with that of McCauley et al. because such a combination would allow the users of Daniels, Jr. et al. the benefit of *authoring multimedia content in a generic format (Column 2, lines 39 – 40).*

4. ***Regarding dependent claim 2***, Daniels, Jr. et al. teach that *the physical delivery printstream is sent from the printstream processor 102 to a printer 104 where the documents in the physical delivery printstream are printed on a tangible medium such as paper. The printed documents are sent to a physical inserter 106 where they are processed into physical mail pieces. For example, a physical mail piece may contain a properly addressed envelope with the proper postage and stuffed with the printed document. In addition, the envelope may include additional printed matter, called physical inserts, selected according to criteria in the control information. The physical mail pieces are then ready for delivery by traditional means, e.g. through the U.S. Postal Service (Column 3, lines 56 – 67), which provide for **printing instructions for driving a printer for printing said messages as at least one document, and wherein said presentation instructions comprise finishing instructions for finishing said at least one document.***

5. **Regarding dependent claim 3 and independent claim 4**, Daniels, Jr. et al.

teach that *the job setup process 520 prompts the user for templates, HTML files, text attachments, e.g. through a dialog box or a form for each electronic delivery mechanism. The job setup process 520 records and enables editing of the user's selections of templates and inserts for each electronic delivery mechanism. The output of the job setup process 520 is a job setup file, e.g. job setup file 402 and job setup file 518 (Column 6, lines 40 – 48). Daniels, Jr. et al. do not explicitly teach **symbol**.*

However, McCauley et al. teach that *hypermedia content is commonly organized as documents or files with embedded control information. The embedded control information includes formatting specifications, indicating how a document is to be rendered by the Web browser. In addition, such control information can include links or "hyperlinks": symbols or instructions telling the Web browser where to find other related WWW documents on the Internet. A hyperlink from one hypermedia topic to another is normally established by the author of a hypermedia document, although some applications allow users to insert hyperlinks to desired topics (Column 1, lines 25 – 35) and since the invention of Daniels, Jr. et al. employs a dialog box; thus, the combined invention provides for **selecting said file of presentation instructions is carried out by selecting a symbol which represents said file of presentation instructions** and for **selecting said file of presentation instructions is carried out by selecting a symbol which represents said file of presentation instructions; activating a send dialog program, subsequently displaying at least one symbol which represents a file of presentation instructions; wherein selecting said file of presentation***

instructions occurs by selecting a symbol which represents said file of presentation instructions, subsequently entering a send command and subsequently at least making ready for mailing said messages in accordance with said selected file of presentation instructions. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Daniels, Jr. et al. with that of McCauley et al. because such a combination would allow the users of Daniels, Jr. et al. the benefit of *authoring multimedia content in a generic format* (Column 2, lines 39 – 40). Further, the limitations not addressed in independent claim 4 incorporate substantially similar subject matter as claim 1 and are rejected along the same rationale.

6. ***Regarding independent claim 5***, Daniels, Jr. et al. teach that *Printstream processor 102 splits the submitted printstream into one of two printstreams based on the addressing information in the delivery preferences. One printstream is a physical delivery printstream ... the other printstream is an electronic delivery printstream ...* (Column 3, lines 43 – 55) and that *if the electronic mail piece is not delivered after a certain length of time, the message router 112 generates and sends a "failed to process" or "failed to deliver" message to status/regeneration processor 118, which (depending on the users configured system, which system is configurable) may cause a physical version of the undelivered electronic mail piece to be produced by printer 104 and physical inserter 106 and delivery by physical means* (Column 4, lines 26 – 33), which provide for ***selecting said presentation instructions occurs under a particular user authorization and by selecting a priorly stored file of presentation***

instructions; and wherein editing said file of presentation instructions occurs, and is executable, exclusively under a different authorization than said user authorization. Further, the limitations not addressed in independent claim 5 incorporate substantially similar subject matter as claim 1 and are rejected along the same rationale.

7. ***Regarding dependent claim 6***, Daniels, Jr. et al. teach that *Printstream* processor 102 splits the submitted printstream into one of two printstreams based on the addressing information in the delivery preferences. One printstream is a physical delivery printstream, in which the documents are to be delivered, as specified in the addressing information, to a physical address via a physical delivery mechanism, for example, the U.S. Postal Service or a courier service (Column 3, lines 43 – 49) and that the physical delivery printstream is sent from the printstream processor 102 to a printer 104 (Column 3, lines 56 – 57), which provide that ***in response to a selection of a different file of presentation instructions, the same peripheral device is driven for at least making ready for mailing another plurality of messages.***

8. ***Regarding dependent claim 7***, Daniels, Jr. et al. teach that the job setup process 520 records and enables editing of the user's selections of templates and inserts for each electronic delivery mechanism. The output of the job setup process 520 is a job setup file, e.g. job setup file 402 and job setup file 518 (Column 6, lines 43 – 47), which provide for ***generating at least one file of presentation instructions in accordance with data selected or entered under said different authorization than said user authorization.*** Daniels, Jr. et al. do not explicitly teach ***storing said file of***

presentation instructions in said computer-readable memory. However, it would have been obvious to one of ordinary skill in the art to know that if the file is generated as output from a process then it must be stored for later use by the program for further processing.

9. ***Regarding dependent claim 8***, Daniels, Jr. et al. illustrates in Figure 1 ***entering data for said file of presentation instructions occurs utilizing universal, interactive client-server operating interface software.***

10. ***Regarding dependent claims 9 and 10***, Daniels, Jr. et al. teach that *if the electronic mail piece is not delivered after a certain length of time, the message router 112 generates and sends a "failed to process" or "failed to deliver" message to status/regeneration processor 118, which (depending on the users configured system, which system is configurable) may cause a physical version of the undelivered electronic mail piece to be produced by printer 104 and physical inserter 106 and delivery by physical means (Column 4, lines 26 – 33), which provide for displaying a message composed in accordance with presentation instructions of said selected file and that displaying said message composed in accordance with presentation instructions of said selected file occurs by means of universal, interactive client-server operating interface software (Fig. 1).*

11. ***Regarding dependent claim 12***, Daniels, Jr. et al. do not explicitly teach ***a test message***. However, Daniels, Jr. et al. do teach that *Printstream processor 102 splits the submitted printstream into one of two printstreams based on the addressing information in the delivery preferences. One printstream is a physical delivery*

printstream ... the other printstream is an electronic delivery printstream ... (Column 3, lines 43 – 55). It would have been obvious to one of ordinary skill in the art to be motivated, based on the disclosure and knowledge of the art, to provide for **composing a test message in accordance with presentation instructions of said selected file and sending said test message to a location of a client system with which said file of presentation instructions has been selected**, since the skilled artisan would want the user to be able to send a “test” message to himself in order to see how the system works and how the recipient would receive the message the user wants to send.

12. **Regarding dependent claim 13**, Daniels, Jr. et al. do not explicitly teach **two different client systems**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the invention of Daniels, Jr. et al. provide that **in response to the selection of said file of presentation instructions through any one of at least two different client systems, the said presentation instructions are used**, since Daniels, Jr. et al. teach that *addressing information in the form of delivery preferences stored in a database* (Column 3, lines 28 – 29) and that *the printstream processor 102 may be an application executing on the same mainframe or an application executing on another computer, e.g. a workstation or PC, networked to the mainframe* (Column 4, lines 41 – 44); the skilled artisan knows that if the invention is run over a network, then multiple clients may access it and since the *addressing information* is stored in a database, then any client may access that same file.

13. **Regarding dependent claim 14**, Daniels, Jr. et al. teach that *addressing information in the form of delivery preferences stored in a database* (Column 3, lines 28

– 29) and that *Printstream processor 102 splits the submitted printstream into one of two printstreams based on the addressing information in the delivery preferences. One printstream is a physical delivery printstream ... the other printstream is an electronic delivery printstream ...* (Column 3, lines 43 – 55) and that *if the electronic mail piece is not delivered after a certain length of time, the message router 112 generates and sends a "failed to process" or "failed to deliver" message to status/regeneration processor 118, which (depending on the users configured system, which system is configurable) may cause a physical version of the undelivered electronic mail piece to be produced by printer 104 and physical inserter 106 and delivery by physical means* (Column 4, lines 26 – 33), which provide for ***in response to the selection of said file of presentation instructions under any one of at least two different user authorizations, the same presentation instructions are used.***

14. ***Regarding dependent claim 15***, Daniels, Jr. et al. teach that a user at a sender's mainframe 100 submits to printstream processor 102 documents in a printstream, addressing information in the form of delivery preferences stored in a database, and control information specifying, e.g., what inserts are to be included with each document in the printstream (Column 3, lines 26 – 31). Daniels, Jr. et al. do not explicitly teach ***two different client systems***. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the invention of Daniels, Jr. et al. provide that ***said file of presentation instructions is stored centrally for coupling presentation instructions according to said file of presentation instructions to content-determining files in response to drive signals***

coming from a any one of at least two different client systems, since Daniels, Jr. et al. teach that *addressing information in the form of delivery preferences stored in a database* (Column 3, lines 28 – 29) and that *the printstream processor 102 may be an application executing on the same mainframe or an application executing on another computer, e.g. a workstation or PC, networked to the mainframe* (Column 4, lines 41 – 44); the skilled artisan knows that if the invention is run over a network, then multiple clients may access it and since the *addressing information is stored in a database*, then any client may access that same file.

15. ***Regarding dependent claim 16***, Daniels, Jr. et al. do not explicitly teach that ***in response to addition or deletion of a file of presentation instructions....*** However, it would have been obvious to one of ordinary skill in the art to know that the disclosed invention provides that ***in response to addition or deletion of a file of presentation instructions, a list of files of presentation instructions in a memory accessible under said user authorization is updated***, since Daniels, Jr. et al. teach that *addressing information in the form of delivery preferences stored in a database* (Column 3, lines 28 – 29); the skilled artisan knows that if files are deleted from the database, then they will no longer be available for the user to choose or use.

16. ***Regarding dependent claim 17***, Daniels, Jr. et al. teach that *the job setup process is an interactive application that allows a user to select templates and inserts for each delivery mechanism from a library ... the job setup process 520 prompts the user for templates, HTML files, text attachments, e.g. through a dialog box or a form for each electronic delivery mechanism. The job setup process 520 records and enables*

*editing of the user's selections of templates and inserts for each electronic delivery mechanism. The output of the job setup process 520 is a job setup file, e.g. job setup file 402 and job setup file 518 (Column 6, lines 28 – 48), which provide that **said list of files of presentation instructions is read and displayed in response to activating a send dialog program.***

17. **Regarding dependent claim 18**, Daniels, Jr. et al. do not explicitly teach **mirror file**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the disclosed invention and provide that **at least one mirror file of presentation instructions coupled to said file of presentation instructions for modifying said mirror file of presentation instructions in response to modifications made in said file of presentation instructions**, since Daniels, Jr. et al. teach that *addressing information in the form of delivery preferences stored in a database* (Column 3, lines 28 – 29); it would be convenient for the user if the skilled artisan kept a mirror file of the current addressing information locally and then stored any changes to the file in the database by overwriting the original file.

18. **Regarding independent claim 19**, the claim incorporates substantially similar subject matter as claim 1, and is reject along the same rationale.

19. **Regarding dependent claim 20**, the claim incorporates substantially similar subject matter as claim 2, and is reject along the same rationale.

20. **Regarding dependent claim 21**, the claim incorporates substantially similar subject matter as claim 3, and is reject along the same rationale.

21. **Regarding independent claim 22**, the claim incorporates substantially similar subject matter as claim 4, and is reject along the same rationale.
22. **Regarding independent claim 23**, the claim incorporates substantially similar subject matter as claim 5, and is reject along the same rationale.
23. **Regarding dependent claim 24**, the claim incorporates substantially similar subject matter as claim 6, and is reject along the same rationale.
24. **Regarding dependent claim 25**, Daniels, Jr. et al. teach that *job setups may be defined by a job setup process 520). The job setup process is an interactive application that allows a user to select templates and inserts for each delivery mechanism from a library. For example, electronic mail library 500 includes templates for formatting electronic mail messages (Column 6, lines 28 – 33), which provide that **instructions for displaying settings concerning presentation instructions; instructions for registering settings concerning presentation instructions as part of a file of presentation instructions in accordance with selected or entered data; and instructions for storing in said computer-readable memory said registered settings concerning presentation instructions as a file of presentation instructions.***
25. **Regarding dependent claim 26**, the claim incorporates substantially similar subject matter as claim 8, and is reject along the same rationale.
26. **Regarding dependent claim 27**, the claim incorporates substantially similar subject matter as claim 9, and is reject along the same rationale.

27. **Regarding dependent claim 28**, the claim incorporates substantially similar subject matter as claim 10, and is reject along the same rationale.
28. **Regarding dependent claim 30**, the claim incorporates substantially similar subject matter as claim 13, and is reject along the same rationale.
29. **Regarding dependent claim 31**, the claim incorporates substantially similar subject matter as claim 14, and is reject along the same rationale.
30. **Regarding dependent claim 32**, the claim incorporates substantially similar subject matter as claim 15, and is reject along the same rationale.
31. **Regarding dependent claim 33**, the claim incorporates substantially similar subject matter as claim 16, and is reject along the same rationale.
32. **Regarding dependent claim 34**, the claim incorporates substantially similar subject matter as claim 17, and is reject along the same rationale.
33. **Regarding dependent claim 35**, the claim incorporates substantially similar subject matter as claim 18, and is reject along the same rationale.
34. **Regarding dependent claim 11**, Daniels, Jr. et al. do not explicitly teach **animation**. McCauley et al. teach that *the instruction stream will often utilize commands and offered features of the requesting client viewer, even though the commands and features are not offered by different client viewers ... The instruction stream might utilize many different capabilities unique to particular types of clients, such as sound, video, animation, recording capabilities, and realtime transmission of these different types of media* (Column 5, lines 31 – 49), which provide for **displaying, in the form of an animation, successive operations for composing a message composed in**

accordance with presentation instructions of said selected file. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Daniels, Jr. et al. with that of McCauley et al. because such a combination would allow the users of Daniels, Jr. et al. the benefit of *authoring multimedia content in a generic format* (Column 2, lines 39 – 40).

Regarding dependent claim 29, the claim incorporates substantially similar subject matter as claim 11, and is reject along the same rationale.

Response to Arguments

35. Applicant's arguments filed 12/08/04 have been fully considered but they are not persuasive.

36. In response to Applicant's argument that Daniels et al. do not disclose selecting a single, priorly stored file of presentation instructions (p 19, first full paragraph), it should be note that Daniels et al. do teach that *the job setup process 520 records and enables editing of the user's selections of templates and inserts for each electronic delivery mechanism. The output of the job setup process 520 is a job setup file, e.g. job setup file 402 and job setup file 518* (Column 6, lines 45 – 48). It should also be noted that the Office uses the broadest reasonable interpretation of the claimed invention(s). Consequently, a single job setup file is created and must be stored prior to usage.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, ***THIS ACTION IS MADE FINAL***. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

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